

U.S.S.N. 10/654,769
7
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

Atty. Dkt. No. 77019

REMARKS/ARGUMENTS

Claims 1-20 remain in this application. Claims 1 and 11 would be amended, upon entry of this amendment. Claims 21-30 have been cancelled.

The amendment to claims 1 and 11 would merely revert the claims to their respective original content as filed and as taken up for examination in the initial Office Action. Therefore, the amendment raises no new issues requiring further consideration and/or search, and it raises no issues of new matter. It also would place the application in better form for any appeal taken by materially simplifying the issues for appeal. It was not earlier presented as it relates to a new position taken in the final Office Action in response to Applicant's previous amendment.

Turning to the specific objections and rejections:

Claim Rejection under 35 U.S.C. § 112, first paragraph

1. Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

While Applicants disagree with this rejection in view of application disclosure as filed, Applicants are deleting and retracting the subject language from claims 1 and 11 in the interest of simplifying and advancing prosecution of the above-captioned application.

U.S.S.N. 10/654,769
8
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

Atty. Dkt. No. 77019

Claim Rejection under 35 U.S.C. § 103(a)

2. Claims 1-20 stand rejected under 35 U.S.C. § 103(a) over Goodnight, Jr. et al. (U.S. Patent No. 4,091,120) in view of Malzahn (U.S. Patent No. 3,852,491).

The final Office Action indicates that these claims stand rejected for the same reasons set forth in the first Office Action dated October 1, 2004, other than some additional commentary that was provided relative to claim language which would be deleted from claims 1 and 11 upon entry of this amendment.

Referencing ¶2 of the Office Action dated October 1, 2004, that Office Action urged, among other things, that Goodnight, Jr. et al. disclose:

... the pH of the [soybean] slurry is adjusted as set forth in the instant claims and the resulting slurry is passed through an ultrafiltration membrane ... (Office Action of 10/1/2004, p. 2).

Applicants point out that Goodnight, Jr. et al. fail to disclose a pH adjustment for 'the resulting slurry ... passed through an ultrafiltration membrane' as set forth in the instant claims.

U.S.S.N. 10/654,769
9
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

Atty. Dkt. No. 77019

Instant claim 1 recites that the soy-containing dough comprises a flour-based dough and a deflavored soy protein material which is prepared by a method which includes, in combination with other steps, the following process steps:

...

(b) solubilizing the soy proteins by adjusting the aqueous composition of (a) to a pH in the range of about 9 to about 12 and releasing the flavoring compounds;

(c) passing the pH-adjusted aqueous composition of (b) adjacent an ultrafiltration membrane having a molecular weight cutoff up to about 50,000 Daltons, while maintaining the pH in the range of about 9 to about 12, under suitable ultrafiltration conditions wherein the flavor compounds pass through the membrane, thereby deflavoring the soy material and retaining substantially all of the solubilized soy proteins;

... (Applicants' emphasis added by underlining).

Instant claim 11 recites similar language to steps (b) and (c) of instant claim 1.

As explained in the present specification, solubilizing the soy proteins in a pH range of about 9 to 12 is important because, in general, a pH of 9 is needed to solubilize all of the proteins, while a pH higher than 12 is likely to cause undesirable degradation of the proteins (page 11, lines 27-31).

Importantly, the pH range of about 9 to about 12 also should be maintained during ultrafiltration to allow as much of the flavoring compounds as possible to be removed (page 12, lines 10-12; Example 1). The relied upon prior art completely fail to appreciate, teach or suggest this important feature of the present invention.

U.S.S.N. 10/654,769
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

10

Atty. Dkt. No. 77019

Applicants point out that Goodnight, Jr. et al. describe a step (a) extraction process conducted at "less than pH 10," and preferably "pH 7 to pH 9 (col. 2, lines 34-37, 63-64). According to Goodnight, Jr. et al., it is preferred not exceed pH 10.0, *inter alia*, during extraction "in the interest of preserving the nutritional quality of the soy protein" (col. 2, lines 52-55).

It is also noted that Goodnight, Jr. et al. describe a step (b) involving separation of spent flakes or meal from the extract using conventional solid separation unit processes to provide a clarified extract for further processing (col. 3, lines 8-23).

Goodnight, Jr. et al. describe a step (c) in which the clarified extract obtained from Goodnight's solid separation step (b) is then subjected to membrane filtration using a semi-permeable membrane, preferably using an ultrafiltration apparatus, in which the membrane has capability to retain dissolved protein and to pass dissolved carbohydrates (col. 3, lines 34-56).

Importantly, Goodright, Jr. et al. state that the clarified extract preferably is adjusted to a pH in the range of pH 6.5 to pH 7.5 prior to membrane filtration (col. 3, lines 39-42).

Goodnight, Jr. et al. also suggest that the 6.5 to 7.5 pH range for ultrafiltration "is not essential" (col. 3, lines 41-42). However, that bare passing comment in the Goodnight Jr. et al. reference is never further developed, nor is an enabling disclosure provided in the Goodnight, Jr. et al. reference for use of different pH during ultrafiltration other than one exclusively in the 6.5 to 7.5 range.

U.S.S.N. 10/654,769
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

11

Atty. Dkt. No. 77019

For instance, in working Example 1 of Goodnight, Jr. et al., the extract charged to ultrafiltration process had a pH of 7.36 (col. 7, lines 21-23). No ultrafiltration process pH value outside the 6.5 to 7.5 range is illustrated by Goodnight, Jr. et al.

In fact, Goodnight, Jr. et al. would have expressly guided and directed one of ordinary skill away from the present invention and instead towards using a pH of 6.5 to 7.5 during ultrafiltration by their following words:

Membrane filtration in the range of pH 6.5 to pH 7.5 has the benefit of minimizing decomposition or interaction of the protein constituents of the extract during the period of membrane filtration which may require several hours. (col. 3, lines 42-46).

In view of at least the above, Applicants respectfully submit that Goodnight Jr., et al. fail to teach and suggest process step (c) of either instant claim 1 or claim 11 reciting ultrafiltration processing with the pH maintained in the range of about 9 to about 12. Moreover, Goodnight Jr., et al. teach and lead away from that possible practice, as discussed above.

U.S.S.N. 10/654,769 12
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

Atty. Dkt. No. 77019

It is well-established that the totality of the prior art must be considered, including portions that would lead away from the claimed invention, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. E.g., *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986) (Applicant's claimed process for sulfonating diphenyl sulfone at a temperature above 127°C was contrary to accepted wisdom because the prior art as a whole suggested using lower temperatures for optimum results as evidenced by charring, decomposition, or reduced yields at higher temperatures).

Applicants submit that the relied upon secondary reference to Malzahn fails to compensate for the above-identified difference or differences existing between the primary reference and the instant claims. Malzahn fails to teach anything relevant about ultrafiltration, much less pH range values for such processes.

Regarding dependent claims 2-10 and 12-20, applicants submit that they are patentable over the relied upon prior art for at least the same reasons as pointed out above relative to their respective ultimate parent claim (i.e., claim 1 or claim 11).

Applicants submit that the above-noted differences between the instant claims and the relied upon prior art are merely exemplary, and Applicants reserve their right to raise additional arguments regarding other differences, as desired or needed.

In view of the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established against any of the present claims 1-20 based on Goodnight, Jr. et al. in combination with Malzahn and, accordingly, they request withdrawal of this rejection.

U.S.S.N. 10/654,769 13
Amdt. After Final dated September 30, 2005
Reply to final Office Action of May 31, 2005

Atty. Dkt. No. 77019

CONCLUSION

In view of the above, it is believed that this application is in condition for allowance, and notice of such is respectfully requested.

Respectfully submitted,

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